REMARKS

Claims 1, 3 to 7, 9 to 11, 13, 14, 16 to 23 and 28 to 35 are currently pending in the present application.

Claims 1, 3 to 7, 9 to 11, 13, 14, 16 to 23 and 28 to 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner is of the opinion that the claims contain subject-matter which was not described in the specification in such a way as to enable one of ordinary skill in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The main objection by the Examiner is directed to applicants' arguments that the present invention uses a homogeneous mixture as compared to the *Abend* reference (U.S. Patent 5,710,215), whereas the *Abend* reference uses an inhomogeneous mixture. The Examiner alleges that *Abend* gives a definition of the term "homogeneous" in order to delimit this term against the non-homogeneous mixtures, whereas the present invention does not contain any definition of the term "homogeneous".

The reason why the present invention does not contain an explicit definition of the term "homogeneous" is that the present invention uses the term "homogeneous" in a usual, conventional manner corresponding to the way one of ordinary skill in the art reading the patent specification would understand this term. In different dictionaries, one can find the definition for the word "homogeneous" as "distributed in a uniform manner", "distributed/dispersed without concentration-gradient", "distributed/dispersed with equal or uniform concentration," etc. This means that according to the usual understanding the term "homogeneous" denotes a uniform concentration without a significant concentration gradient. As it is always the case in natural sciences, there does not exist any absolute value on an atomic or molecular level in natural sciences so that – as the Examiner correctly states – no mixture is truly homogeneous on an

atomic or molecular level. But this is not the usual understanding with which one of ordinary skill in the art uses the term "homogeneous". The term "homogeneous" is usually used by one of ordinary skill in the art as meaning a state having **essentially** no deviating concentrations.

In contrast to this, the *Abend* reference uses the term "homogeneous" against the usual understanding of the skilled practitioner by saying that homogeneous means that the concentration of components in one mm^2 does not deviate by more than 2% from the average value within the entire mixture (col. 7, lines 53 to 57 of the *Abend* reference). Since the *Abend* reference does not comply with the usual understanding of the term "homogeneous", this reference has to give a definition according to which this term should be understood in the terms of the *Abend* reference. Thus, each patentee is his own lexicographer. If in a patent specification a term is to be used in a manner deviating from its common meaning, such patent specification needs to contain a definition as to how this term is to be understood. This is the reason why the *Abend* reference contains a definition of the term "homogeneous" and the present application does not nor does it not need to. The *Abend* reference clearly delimits the homogeneous areas against the non homogeneous areas within the same adhesive preparation. This is the reason why one finds a definition of the term "homogeneous" in the *Abend* reference and why it is not needed in the present application.

Furthermore, the Examiner objects that in the present application does not specify how the components are mixed and what polyisocyanate particles sizes would enable homogeneity. Such factors are not critical in obtaining homogeneity. Since conventional mixing of the components leads to an essentially homogeneous distribution in the sense of the present invention and as commonly performed by one of ordinary skill in the art, any conventional mixing method can be applied with any polyisocyanate particles sizes, thus leading to homogeneous mixing. This is the reason why there are no further details given in the present

patent specification how the homogeneous mixing shall be performed. The present patent specification is directed to one of ordinary skill in the art, and he will decide which mixing technique is to be used in order to reach homogeneous distribution.

In addition, the present invention contains several indications how the conventional mixing can be performed:

On page 12, lines 18 ff. of the present invention, it is stated that the individual constituents (contents) are mixed while mildly heating without a notable reaction between the individual constituents (contents) taking place in the case of solid isocyanates.

A more detailed description is given on page 12, lines 31 ff. of the present invention where it reads:

> *"The individual constituents (contents) of the reactive hot-melt adhesive element according to the present invention can be mixed in an extruder, for example. As an alternative, however, conventional mixer can be used."*

From this description of the present invention, it becomes absolutely clear to one of ordinary skill in the art how the conventional mixing of the present invention can be performed. From this description, it becomes also clear what is meant by the term "homogeneous" in the context of the present invention although no specific definition is given – because no definition is needed for the reasons delineated above.

In contrast to this, the *Abend* reference explicitly intends a non-homogeneous distribution. For this purpose, the *Abend* reference uses uncommon techniques. This is the reason why – in contrast to the present invention – in the *Abend* reference it has to be explained in detail how a non homogeneous distribution of the components can be reached. For this purpose, one of ordinary skill in the art is taught to use a completely or partially heated two-component mixing machine with static mixer as commonly used for processing two-component coatings, sealants and adhesives (see col. 7, lines 15 to 31 of the *Abend* reference).

Accordingly, it is respectfully requested that the rejection of claims 1, 3 to 7, 9 to 11, 13, 14, 16 to 23 and 28 to 35 under 35 U.S.C. 112, first paragraph, be withdrawn.

It should be emphasized that the difference between the present invention and the *Abend* reference not only lies in the partially non-homogeneous distribution according to the *Abend* reference.

The *Abend* reference requires the use of surface-deactivated isocyanates and is limited to this embodiment whereas the present invention allows for a much broader variety of liquid and solid isocyanates. Furthermore, the *Abend* reference allows only for a small amount of further additives and does not show the use of significant amounts of a further component, let alone of a non-isocyanate-reactive polymer, wax and/or resin as used according to the present invention. The reason is quite simple: The *Abend* reference uses another solution to reach sufficient stability within the claimed system, namely the non-homogeneous distribution of isocyanates and isocyanate-reactive polymers.

Claim 11 is objected to under 37 C.F.R. 1.75(c). In response, claim 11 is cancelled, rendering the present rejection moot.

Finally new prior art has been obtained in the corresponding European and German cases. These references are submitted in the enclosed Supplemental Information Disclosure Statement.

It is respectfully submitted that the pending claims are now in a condition for allowance, early notice of which is earnestly requested. Should the Examiner have any further questions regarding the present application, the undersigned is available to discuss the present application with the Examiner.

It is believed that no fees or charges are required at this time in connection with the present application; however, if any fees or charges are required at this time, they may be

charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE

By _____

Thomas C. Pontani, Reg. No. 29,763
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: November 18, 2004